

REMARKS

Reconsideration and withdrawal of the rejections of the Office Action are respectfully requested in view of the amendments and remarks herein. The Examiner is thanked for withdrawing the rejection under 35 U.S.C. §102.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1,-44, 47 and 49 are currently pending. Claims 1 and 49 have been amended, without prejudice, without admission, without surrender of subject matter, and without any intention of creating any estoppel as to equivalents.

No new matter is added.

It is submitted that these claims are in full compliance with the requirements of 35 U.S.C. §112. The amendments to the claims and the remarks herein are not made for the purpose of patentability within the meaning of 35 U.S.C. §§ 101, 102, 103 or 112; but rather the amendments and remarks are made simply for clarification and to round out the scope of protection to which Applicants are entitled. Support for the present amendment is found throughout the specification, and the claims as originally and previously pending.

II. THE REJECTIONS UNDER 35 U.S.C. §112 ARE OVERCOME

Claims 1 and 49 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Applicants respectfully traverse.

Specifically, the Office Action alleges that it is unclear whether the coating for the first food material and the barrier composition are the same composition. Applicants respectfully submit that the claims have been amended herein to recite that the food material is coated with the barrier composition, thereby rendering the rejection moot.

Consequently reconsideration and withdrawal of the rejection under 35 U.S.C. §112, second paragraph, is respectfully requested.

Claim 1 was also rejected under 35 U.S.C. §112, first paragraph, as allegedly lacking enablement when the coating is not also the barrier composition. Applicants respectfully traverse.

As stated above, the claims have been amended herein to recite that the food material is coated with the barrier composition, such that the coating composition is the barrier composition, thereby rendering the rejection moot.

Consequently, reconsideration and withdrawal of the rejections under 35 U.S.C. §112, first paragraph, is respectfully requested.

III. THE ART REJECTIONS ARE OVERCOME

Claims 1-44, 47 and 49 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Woldhuis (EP 0 403 030) in view of any of Loh or Gaonkar or Smith. The rejections are respectfully traversed and will be addressed together.

Applicants respectfully assert that in order to ground an obviousness rejection, there must be some teaching which would have provided the necessary incentive or motivation for modifying the reference's teaching. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (B.P.A.I. 1993). Further, "obvious to try" is not the standard under 35 U.S.C. §103. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). And as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification." Also, the Examiner is respectfully reminded that for the Section 103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicants' disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

The present invention relates to a multi-component foodstuff comprising (a) a first food material; (b) a barrier composition; and (c) a second food material, wherein the barrier composition prevents water migration from one component into another within the foodstuff.

Applicants respectfully assert that Woldhuis fails to teach or suggest **all** of the elements of the claimed invention.

The Office Action alleges that Woldhuis relates to a coating for cheese made of wax and a wax-like fat of the composition of the claims and utilizes Loh or Gaonkar or Smith for the recitation of a multi-component.

Applicants respectfully submit that the reading of Woldhuis is deficient. The objective of Woldhuis (EP 0403 030) is to prevent drying out of the cheese (see page 2, line 16; and the

section starting at page 10 line 44, in particular, page 11, line 35). The drying of the cheese is again highlighted as the technical problem to be solved on page 3 lines 27-31. This drying of the cheese may or may not be a problem to the consumer (there is no mention of mouth feel or any other organoleptic observations in Woldhuis), but it is certainly a factor for the cheese business which sells its products based on weight. The preferred coating in Woldhuis retards water evaporation from 11.2% to under 0.3% (see Table E, page 11). Since cheese is usually measured in weight, the findings of Woldhuis equate to an instant effective increase in sales revenue for cheese manufacturers of 10% compared to untreated cheese. Thus, the real contribution to the industry provided by Woldhuis is the provision of an alternative wax-like peelable layer to maintain cheese weight.

The water loss for cheeses in Woldhuis was measured over 5 weeks at 13°C and relative air humidity of 65-75%. Clearly these conditions do not correspond to those experienced within foodstuffs such as desserts, as described in the present patent application. The osmotic potential present in desserts would be much more severe (representing a far more stringent test for a water barrier). Furthermore, the osmotic potential would flow in the opposite direction in desserts to that considered in Woldhuis. For example, consider an uncoated portion of cheese present in a dessert product. The cheese would not dry out, but would become very wet (likely too soggy to meet consumer satisfaction) over the time required for transportation and storage/display. Although there are many water barriers known in the art, not all are suitable for such an application. Applicants respectfully submit that the test criteria applied in Woldhuis would not lead a person skilled in the art to use Woldhuis' barrier in a multi-component foodstuffs such as desserts.

Furthermore, Woldhuis states that the coating layer should be "peelable" (see the "advantageous characteristics" listed on page 2, line 29, of Wodlhuis). This requirement entails that at least a significant number of consumers would not wish to eat the waxy moisture barrier disclosed in Woldhuis. In contrast, removal of the moisture barrier in the present invention is neither desirable nor practical. Indeed, in preferred embodiments, the layer is so thin that it does not have sufficient tensile strength to be removed by peeling. Indeed, the importance of peelability to the teachings of Woldhuis is shown in the measurements of tensile strength for each of the barrier layers tested in Woldhuis.

Therefore, Woldhuis teaches a peelable layer designed to prevent water loss from cheese by evaporation into air. This is not a problem that would be of concern to someone skilled in the art attempting to produce a multi-component foodstuff (such as a dessert) highly resistant to INTERNAL water migration within the foodstuff and intended for sale in a sealed container. Therefore, Applicants respectfully submit that Woldhuis is based on tests and selection criteria inappropriate for the selection of a barrier layer for use in multi-component foodstuff (e.g. dessert) and, furthermore, that a person skilled in the art would as a consequence not have looked to use a layer as described in Woldhuis in a multi-component foodstuff as provided in the present invention.

Furthermore, Applicants respectfully submit that none of the references combined with Woldhuis in the Office Action correct the deficiencies of Woldhuis as described above. Specifically, each of Loh, Gaonkar and Smith were cited for the sole disclosure of multi-component foodstuffs containing cheese. None of these additionally cited references teach a barrier composition as provided in the instant invention, and hence do not anticipate or render obvious the present invention, either alone or in combination with Woldhuis.

In addition, Applicants respectfully submit that besides failing to overcome the deficiencies of Woldhuis, the additionally cited references cannot be properly cited under 35 U.S.C. §102 or §103.

Smith was filed February 24, 2003 and published August 26, 2004. The present application was filed October 31, 2003 and claims priority to US Provisional Application No. 60/443,450 filed January 29, 2003 and UK Patent Application 0301869.4 filed January 27, 2003. Thus, the present application has a date of invention of at least January 27, 2003 on the basis of the priority documents, which is earlier in time than both the filing and publication of Smith. Accordingly, Smith is not citeable under either §102 or §103.

Furthermore, enclosed herewith is a Declaration from the inventors under 37 C.F.R. 1.131 indicating that the date of invention for the present application is at least prior to November 26, 2002, the date of filing of Loh and the earliest priority date of Gaonkar. Submitted in support of the Declaration is a Technical Report authored by one of the inventors of the present application, lab notebook pages, and a communication with the outside European Patent Attorney regarding the preparation of a patent application.

That is, the present invention was conceived and reduced to practice prior to November 26, 2002; accordingly, none of Smith, Loh or Gaonkar are prior art under 35 U.S.C. §102 or §103, such that the rejection utilizing these references must be withdrawn.

As Woldhuis is insufficient as described above, and as none of Smith, Loh and Gaonkar can be properly combined with Woldhuis (nor do any of the references remedy the deficiencies in Woldhuis), the §103 rejection cannot stand. Reconsideration and withdrawal of the rejection under 35 U.S.C. §103 is therefore respectfully requested.

REQUEST FOR INTERVIEW

If any issue remains as an impediment to allowance, an interview with the Examiner and her supervisor, is respectfully requested, prior to issuance of any paper other than a Notice of Allowance; and, the Examiner is respectfully requested to contact the undersigned to arrange a mutually convenient time and manner for such an interview.

CONCLUSION

In view of the remarks herewith, the application is in condition for allowance. Reconsideration and withdrawal of the rejections of the application, and prompt issuance of a Notice of Allowance, are respectfully requested.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP

By: /Angela M. Collison/
Thomas J. Kowalski
Reg. No. 32,147
Angela M. Collison
Reg. No. 51,107
Tel.:(212) 588-0800
Fax.:(212) 588-0500